

ESTTA Tracking number: **ESTTA543982**

Filing date: **06/19/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Zendesk, Inc.
Granted to Date of previous extension	06/26/2013
Address	989 Market Street, Suite 300 San Francisco, CA 94103 UNITED STATES
Attorney information	Miguel C. Danielson Danielson Legal LLC 1 Mifflin Place, Suite 400 Cambridge, MA 02138 UNITED STATES tmadmin@danielsonlegal.com Phone:6177145386

### Applicant Information

Application No	85736477	Publication date	02/26/2013
Opposition Filing Date	06/19/2013	Opposition Period Ends	06/26/2013
Applicant	zenbilling, LLC 302 Washington St. #150-1142 San Diego, CA 92103 UNITED STATES		

### Goods/Services Affected by Opposition

Class 042. First Use: 2010/06/01 First Use In Commerce: 2010/06/01  
All goods and services in the class are opposed, namely: Software as a service (SAAS) services featuring software for use in lead management, sales administration, billing, subscription management, participant management, and delivery of online video, audio, and live content, for businesses in the field of personal development, skill development, and business development

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3818497	Application Date	01/16/2009
Registration Date	07/13/2010	Foreign Priority Date	07/17/2008
Word Mark	ZENDESK		

Design Mark	
Description of Mark	NONE
Goods/Services	<p>Class 009. First use:  [ Recorded and downloadable computer software, namely, computer software for business management, database management, customer service management and management of customer relations; software for electronic communications ] * Recorded and downloadable computer software, namely, computer software for business information and communications management, business database management, customer service management and management of customer relations all of the foregoing directed to the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; software for electronic communications within businesses and between businesses and their customers, all of the foregoing in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality *</p> <p>Class 035. First use:  Assistance in business management and business administration; compilation and systematization of information into computer databases; business information provided through local and global computer networks; rental of advertising space on the internet; retail store and on-line retail store services featuring computer software</p> <p>Class 038. First use:  Telecommunications, namely, transmission of communications, information and data through local and global computer networks; communication services, namely, transmission of voice, audio, visual images and data by local and global computer networks; rental of access time to global computer networks, namely, providing telecommunications access to databases relating to management of customer relationships</p> <p>Class 042. First use:  [ Computer programming; design, development and customization of computer software; rental of computer programs or applications software which enables the compilation and processing of data for central database through local and global networks; providing temporary use of on-line non-downloadable software, namely, graphical user interface software for use in managing customer relationships ] * Computer programming in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; design, development and customization of computer software in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; rental of computer programs or applications software which enables the compilation and processing of data for central database through local and global networks directed to the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; providing temporary use of on-line non-downloadable software, namely, graphical user interface software for use in managing customer relationships, all of the foregoing in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality *</p>
Attachments	Zendesk-Zenbilling Notice of Opposition (F Complete 6.19.13).pdf(355863 bytes )

## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Miguel Danielson/
Name	Miguel C. Danielson
Date	06/19/2013

IN THE UNITED STATES PATENT & TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Zendesk, Inc.	)	
	)	
<i>Opposer,</i>	)	Opposition No.: _____
	)	
v.	)	Application No. 85736477
	)	
zenbilling, LLC	)	
	)	
<i>Applicant</i>	)	
	)	

**NOTICE OF OPPOSITION**

Zendesk, Inc., a Delaware corporation with a business address of 989 Market Street, Suite 300, San Francisco, CA 94103 (“Opposer”), believes that it will be damaged by the registration of the mark ZENBILLING, which is the subject of United States Trademark Application No. 85736477, held in the name of zenbilling, LLC (“Applicant”), and hereby opposes the registration of said mark. Opposer is misidentified in U.S. Registration No. 3818497 as a Massachusetts Corporation due to a clerical error of the International Bureau of the World Intellectual Property Organization; a request for correction has been duly filed and is now pending with the International Bureau.

As grounds for opposition, it is alleged that:

1. Applicant seeks to register the trademark ZENBILLING for “Software as a service (SAAS) services featuring software for use in lead management, sales administration, billing, subscription management, participant management, and delivery of online video, audio, and live content, for businesses in the field of personal development, skill development, and business development,” in Class 42.

2. The opposed application was filed on September 24, 2012, claiming a date of first use and a date of first use in commerce of June 1, 2010, under Section 1(a) of the Trademark Act.

3. Opposer is owner of United States Registered Extension of Protection, Reg. No. 3818497 (the "Registration"), under Section 66(a) of the Trademark Act for the mark ZENDESK in connection with "computer programming in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; design, development and customization of computer software in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; rental of computer programs or applications software which enables the compilation and processing of data for central database through local and global networks directed to the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; providing temporary use of on-line non-downloadable software, namely, graphical user interface software for use in managing customer relationships, all of the foregoing in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality," in Class 42, and "Assistance in business management and business administration; compilation and systematization of information into computer databases; business information provided through local and global computer networks; rental of advertising space on the internet; retail store and on-line retail store services featuring computer software," in Class 35. The foregoing Registration was filed based on International Registration No. 1001362 and claims Paris Convention priority to Denmark Trademark Application No.

VA200802820, filed on July 17, 2008. Accordingly, Opposer's rights in the ZENDESK mark, in connection with the aforementioned services, enjoy priority as of such date. A copy of the TSDR database printout showing the current title and status of the mark is attached hereto as Exhibit A.

4. Opposer, or its predecessor in interest, is the owner of common law rights accrued in the ZENDESK mark as used in connection with the above-referenced services as well as additional goods and services, such rights having accrued prior to Applicant's filing date.

5. Opposer's services as identified in its above-listed Registration, and as may exist at common law, are closely related to, and similar in nature to, the services identified in Application Serial No. 85736477. On information and belief, Opposer's services and Applicant's services are offered to the same classes of customers through the same channels of trade.

6. Applicant's applied-for mark is substantially and confusingly similar to Opposer's mark ZENDESK. Use of the applied-for mark by Applicant for the services identified in Application Serial No. 85736477 will be likely to cause confusion, mistake, and/or deception of the relevant trade and public. Customers and potential customers are likely to believe that Applicant's services offered under the applied-for mark emanate from, or are licensed or approved by, Opposer, when that is not the case. Such confusion, mistake, and/or deception would be a source of damage to Opposer.

7. Because Applicant's applied-for mark is likely to cause confusion with Opposer's above-identified mark ZENDESK, Applicant's mark should be refused registration under Section 2(d) of the Trademark Act.

8. If Applicant is granted the registration herein opposed, it would thereby obtain a *prima facie* right to exclusive use of the applied-for mark, which would be a further source of damage to Opposer.

\*\*\*\*\*

WHEREFORE, Opposer believes that it will be damaged by registration of said mark, and prays that this Opposition be sustained, that Application Serial No. 85736477 be rejected, and that the mark applied for therein be refused registration.

Respectfully submitted,

ZENDESK, INC.

By:



Miguel C. Danielson  
Attorney for Opposer  
DANIELSON LEGAL LLC  
1 Mifflin Place, Ste 400  
Cambridge, MA 02138  
Tel.: (617) 714-5386  
Fax: (888) 742-8097

**Exhibit A**

TSDR Printout of ZENDESK Registration No. 3818497



**Generated on:** This page was generated by TSDR on 2013-06-19 15:22:55 EDT

**Mark:** ZENDESK

ZENDESK

**US Serial Number:** 79068289

**Application Filing Date:** Jan. 16, 2009

**US Registration Number:** 3818497

**Registration Date:** Jul. 13, 2010

**Register:** Principal

**Mark Type:** Trademark, Service Mark

**Status:** Registered. The registration date is used to determine when post-registration maintenance documents are due.

**Status Date:** Jul. 13, 2010

**Publication Date:** Mar. 23, 2010

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## Mark Information

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**Mark Literal Elements:** ZENDESK

**Standard Character Claim:** Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

**Mark Drawing Type:** 4 - STANDARD CHARACTER MARK

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## Related Properties Information

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**International Registration Number:** 1001362

**International Registration Date:** Jan. 16, 2009

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## Goods and Services

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**Note:** The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks \*...\* identify additional (new) wording in the goods/services.

**For:** [ Recorded and downloadable computer software, namely, computer software for business management, database management, customer service management and management of customer relations; software for electronic communications ] \* Recorded and downloadable computer software, namely, computer software for business information and communications management, business database management, customer service management and management of customer relations all of the foregoing directed to the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; software for electronic communications within businesses and between businesses and their customers, all of the foregoing in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality \*

**International Class(es):** 009 - Primary Class

**U.S Class(es):** 021, 023, 026, 036, 038

**Class Status:** ACTIVE

**Basis:** 66(a)

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**For:** Assistance in business management and business administration; compilation and systematization of information into computer databases; business information provided through local and global computer networks; rental of advertising space on the internet; retail store and on-line retail store services featuring computer software

**International Class(es):** 035 - Primary Class

**U.S Class(es):** 100, 101, 102

**Class Status:** ACTIVE

**Basis:** 66(a)

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**For:** Telecommunications, namely, transmission of communications, information and data through local and global computer networks; communication services, namely, transmission of voice, audio, visual images and data by local and global computer networks; rental of access time to global computer networks, namely, providing telecommunications access to databases relating to management of customer relationships

**International Class(es):** 038 - Primary Class

**U.S Class(es):** 100, 101, 104

**Class Status:** ACTIVE

**Basis:** 66(a)

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**For:** [ Computer programming; design, development and customization of computer software; rental of computer programs or applications software which enables the compilation and processing of data for central database through local and global networks; providing temporary use of on-line non-downloadable software, namely, graphical user interface software for use in managing customer relationships ] \* Computer programming in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; design, development and customization of computer software in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; rental of computer programs or applications software which enables the compilation and processing of data for central database through local and global networks directed to the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; providing temporary use of on-line non-downloadable software, namely, graphical user

interface software for use in managing customer relationships, all of the foregoing in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality \*

**International Class(es):** 042 - Primary Class

**U.S Class(es):** 100, 101

**Class Status:** ACTIVE

**Basis:** 66(a)

## Basis Information (Case Level)

**Filed Use:** No

**Currently Use:** No

**Amended Use:** No

**Filed ITU:** No

**Currently ITU:** No

**Amended ITU:** No

**Filed 44D:** No

**Currently 44D:** No

**Amended 44D:** No

**Filed 44E:** No

**Currently 44E:** No

**Amended 44E:** No

**Filed 66A:** Yes

**Currently 66A:** Yes

**Filed No Basis:** No

**Currently No Basis:** No

## Current Owner(s) Information

**Owner Name:** Zendesk, Inc.

**Owner Address:** 989 Market St. Ste 300  
San Francisco CA 94103  
UNITED STATES

**Legal Entity Type:** CORPORATION

**State or Country Where  
Organized:** MASSACHUSETTS

## Attorney/Correspondence Information

### Attorney of Record

**Attorney Name:** Miguel Danielson

**Docket Number:** ZEN-601 US

**Attorney Primary Email  
Address:** [tmadmin@danielsonlegal.com](mailto:tmadmin@danielsonlegal.com)

**Attorney Email  
Authorized:** Yes

### Correspondent

**Correspondent  
Name/Address:** Miguel Danielson  
Danielson Legal LLC  
1 Mifflin Place, Suite 400  
Cambridge, MASSACHUSETTS 02138  
UNITED STATES

**Phone:** 617-714-5386

**Fax:** 888-742-8097

**Correspondent e-mail:** [tmadmin@danielsonlegal.com](mailto:tmadmin@danielsonlegal.com)

**Correspondent e-mail  
Authorized:** Yes

### Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Jun. 01, 2013	CHANGE OF NAME/ADDRESS REC'D FROM IB	
May 25, 2013	PARTIAL INVALIDATION OF REG EXT PROTECTION CREATED	
Feb. 12, 2013	FINAL DECISION TRANSACTION PROCESSED BY IB	
Sep. 25, 2012	AMENDMENT UNDER SECTION 7 - ISSUED	73376
Aug. 28, 2012	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	73376
Aug. 27, 2012	TEAS SECTION 7 REQUEST RECEIVED	
Nov. 02, 2010	FINAL DISPOSITION NOTICE SENT TO IB	
Nov. 02, 2010	FINAL DISPOSITION PROCESSED	72589
Oct. 13, 2010	FINAL DISPOSITION NOTICE CREATED, TO BE SENT TO IB	
Jul. 16, 2010	ATTORNEY REVOKED AND/OR APPOINTED	
Jul. 16, 2010	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Jul. 13, 2010	REGISTERED-PRINCIPAL REGISTER	
Jun. 07, 2010	EXTENSION OF TIME TO OPPOSE PROCESS - TERMINATED	
Apr. 20, 2010	EXTENSION OF TIME TO OPPOSE RECEIVED	
Mar. 23, 2010	PUBLISHED FOR OPPOSITION	

Mar. 03, 2010	NOTICE OF PUBLICATION	
Feb. 17, 2010	LAW OFFICE PUBLICATION REVIEW COMPLETED	66213
Feb. 04, 2010	ASSIGNED TO LIE	66213
Jan. 12, 2010	APPROVED FOR PUB - PRINCIPAL REGISTER	
Dec. 14, 2009	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Dec. 14, 2009	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Dec. 14, 2009	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Sep. 18, 2009	CHANGE OF OWNER RECEIVED FROM IB	
Jul. 24, 2009	REFUSAL PROCESSED BY IB	
Jun. 16, 2009	NON-FINAL ACTION MAILED - REFUSAL SENT TO IB	
Jun. 16, 2009	REFUSAL PROCESSED BY MPU	74217
Jun. 14, 2009	NON-FINAL ACTION (IB REFUSAL) PREPARED FOR REVIEW	
Jun. 13, 2009	NON-FINAL ACTION WRITTEN	74301
Jun. 09, 2009	APPLICATION FILING RECEIPT MAILED	
Jun. 05, 2009	ASSIGNED TO EXAMINER	74301
Jun. 05, 2009	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jun. 04, 2009	SN ASSIGNED FOR SECT 66A APPL FROM IB	

## International Registration Information (Section 66a)

<b>International Registration Number:</b>	1001362	<b>International Registration Date:</b>	Jan. 16, 2009
<b>Priority Claimed Flag:</b>	Yes	<b>Date of Section 67 Priority Claim:</b>	Jul. 17, 2008
<b>Intl. Registration Status:</b>	REQUEST FOR EXTENSION OF PROTECTION PROCESSED	<b>Date of International Registration Status:</b>	Jun. 04, 2009
<b>Notification of Designation Date:</b>	Jun. 04, 2009	<b>Date of Automatic Protection:</b>	Dec. 04, 2010
<b>International Registration Renewal Date:</b>	Jan. 16, 2019		
<b>First Refusal Flag:</b>	Yes		

## Maintenance Filings or Post Registration Information

**Change in Registration:** Yes

<b>Amendment to a Registration/Renewal Certificate:</b>	In the Statement, lines 4-7, "Recorded and downloadable computer software, namely, computer software for business management, database management, customer service management and management of customer relations; software for electronic communications" is deleted, and, "Recorded and downloadable computer software, namely, computer software for business information and communications management, business database management, customer service management and management of customer relations all of the foregoing directed to the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; software for electronic communications within businesses and between businesses and their customers, all of the foregoing in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality" is inserted, and, In the Statement, lines, 21-27, "Computer programming; design, development and customization of computer software; rental of computer programs or applications software which enables the compilation and processing of data for central database through local and global networks; providing temporary use of on-line non-downloadable software, namely, graphical user interface software for use in managing customer relationships" is deleted, and, "Computer programming in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; design, development and customization of computer software in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; rental of computer programs or applications software which enables the compilation and processing of data for central database through local and global networks directed to the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality; providing temporary use of on-line non-downloadable software, namely, graphical user interface software for use in managing customer relationships, all of the foregoing in the fields of customer support, customer relationship management, customer service, customer engagement, and helpdesk functionality" is inserted.
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## TM Staff and Location Information

<b>TM Staff Information - None</b>		
<b>File Location</b>		
<b>Current Location:</b>	POST REGISTRATION	<b>Date in Location:</b> Sep. 25, 2012

## Assignment Abstract Of Title Information

### Summary

**Total Assignments:** 2

**Registrant:** Zendesk, Inc.

### Assignment 1 of 2

Conveyance: ASSIGNS THE ENTIRE INTEREST

Reel/Frame: [4064/0731](#)

Pages: 2

Date Recorded: Sep. 18, 2009

Supporting Documents: [assignment-tm-4064-0731.pdf](#)

#### Assignor

Name: [ZENDESK APS](#)

Execution Date: Aug. 31, 2009

Legal Entity Type: UNKNOWN

State or Country Where Organized: DENMARK

#### Assignee

Name: [ZENDESK, INC.](#)

Legal Entity Type: CORPORATION OF THE STATE OF MASSACHUSETTS, USA

State or Country Where Organized: No Place Where Organized Found

Address: 107 SOUTH STREET, #3A  
BOSTON, MA 02111, UNITED STATES

#### Correspondent

Correspondent Name: ZENDESK, INC.

Correspondent Address: 107 SOUTH STREET, #3A  
BOSTON, MA 02111  
UNITED STATES

#### Domestic Representative - Not Found

### Assignment 2 of 2

Conveyance: CHANGE OF ADDRESS

Reel/Frame: [5037/0863](#)

Pages: 2

Date Recorded: Jun. 01, 2013

Supporting Documents: [assignment-tm-5037-0863.pdf](#)

#### Assignor

Name: [ZENDESK, INC.](#)

Execution Date: May 07, 2013

Legal Entity Type: UNKNOWN

State or Country Where Organized: UNITED STATES

#### Assignee

Name: [ZENDESK, INC.](#)

Legal Entity Type: NOT PROVIDED

State or Country Where Organized: NOT PROVIDED

Address: 989 MARKET ST. STE 300  
SAN FRANCISCO CA 94103, UNITED STATES

#### Correspondent

Correspondent Name: ZENDESK, INC.

Correspondent Address: 989 MARKET ST. STE 300  
SAN FRANCISCO CA 94103  
UNITED STATES

#### Domestic Representative - Not Found

## Proceedings

#### Summary

Number of Proceedings: 2

#### Type of Proceeding: Opposition

Proceeding Number: [91210613](#)

Filing Date: May 08, 2013

Status: Pending

Status Date: May 08, 2013

Interlocutory Attorney: GEORGE POLOGEORGIS

#### Defendant

Name: ZenPayroll, Inc.

Correspondent Address: THOMAS H. ZELLERBACH & KRISTIN S. CORNUE  
ORRICK, HERRINGTON & SUTCLIFFE LLP  
2050 MAIN ST STE 1100  
IRVINE CA , 92614-8280

Correspondent e-mail: [cellerbach@fenwick.com,trademarks@fenwick.com](mailto:cellerbach@fenwick.com,trademarks@fenwick.com)

#### Associated marks

Mark

Application Status

Serial  
Number

Registration  
Number

**Plaintiff(s)****Name:** Zendesk, Inc.**Correspondent Address:** Miguel Danielson  
Danielson Legal LLC  
1 Mifflin Place, Suite 400  
Cambridge MA , 02138  
UNITED STATES**Correspondent e-mail:** [miguel@danielsonlegal.com](mailto:miguel@danielsonlegal.com)**Associated marks**

Mark	Application Status	Serial Number	Registration Number
ZENDESK	Registered	<a href="#">79068289</a>	<a href="#">3818497</a>

**Prosecution History**

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	May 08, 2013	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	May 15, 2013	Jun 24, 2013
3	PENDING, INSTITUTED	May 15, 2013	
4	STIP FOR EXT	Jun 06, 2013	
5	EXTENSION OF TIME GRANTED	Jun 06, 2013	

**Type of Proceeding: Extension of Time****Proceeding Number:** [79068289](#)**Filing Date:** Apr 20, 2010**Status:** Terminated**Status Date:** Jun 07, 2010**Interlocutory Attorney:****Defendant****Name:** Zendesk, Inc.**Correspondent Address:** Zacco Denmark A/S  
Hans Bekkevolds Allé 7  
DK-2900 Hellerup DENMARK**Associated marks**

Mark	Application Status	Serial Number	Registration Number
ZENDESK	Registered	<a href="#">79068289</a>	<a href="#">3818497</a>

**Potential Opposer(s)****Name:** Citrix Systems, Inc.**Correspondent Address:** Deborah J. Peckham  
Burns & Levinson LLP  
125 Summer Street  
Boston MA , 02110  
UNITED STATES**Correspondent e-mail:** [trademarks@burnslev.com](mailto:trademarks@burnslev.com)**Prosecution History**

Entry Number	History Text	Date	Due Date
1	INCOMING - EXT TIME TO OPPOSE FILED	Apr 20, 2010	
2	EXTENSION OF TIME GRANTED	Apr 20, 2010	

**CERTIFICATE OF SERVICE**

I, Miguel Danielson, hereby certify that on this 19th day of June, 2013, a true and correct copy of the foregoing NOTICE OF OPPOSITION has been served, by First Class U.S. Mail, postage prepaid, to:

zenbilling, LLC  
302 Washington St. #150-1142  
San Diego, CA 92103



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Miguel C. Danielson  
Attorney for Opposer  
DANIELSON LEGAL LLC  
1 Mifflin Place, Ste 400  
Cambridge, MA 02138  
Tel.: (617) 714-5386  
Fax: (888) 742-8097